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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
29250-000203/US/COA

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On _____

Signature _____

Typed or printed name _____

Application Number
10/602,588Filed
June 25, 2003First Named Inventor
Douglas RollenderArt Unit
2617Examiner
Inder Behra

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)☒ attorney or agent of record.
Registration number 35,416.☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Gary D. Yacura No. 641,088
Signature
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Typed or printed name

703-668-8000
Telephone numberMay 19, 2010
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.



PATENT
29250-000203/US/COA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANTS: Douglas Rollender CONF. NO.: 1441
APPLN. NO.: 10/602,588 ART UNIT: 2617
FILED: June 25, 2003 EXAMINER: Inder Mehra
FOR: METHOD OF TRANSFERRING DATA
DOCKET No.: 29250-000203/US/COA

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Mail Stop AF

May 19, 2010

REASONS FOR PRE-APPEAL REQUEST FOR REVIEW

Dear Sir:

Appellants hereby request review of the December 30, 2009 Final Rejection of this application. Claims 1-32 are pending in the current application. Claims 13-28 and 31 are allowed. Claims 1-12, 29-30 and 32 are finally rejected. Claims 1, 13, 26 and 31-32 are the independent claims.

Appellants seek the panel's review of the rejection of claims 1-12, 29-30 and 32 under 35 U.S.C. §103(a) as being unpatentable over Applicants' Admitted Prior Art (APA) in view of Solomon (Non-Patent Literature), Willey (U.S. Patent No. 6,505,058), and further in view of Billstrom (U.S. Patent No. 5,729,537) because of clear errors in the Examiner's rejection and/or the Examiner has omitted one or more essential elements needed for a prima facie rejection. The Examiner has withdrawn the rejection under 35 U.S.C. §112.¹

The claimed invention relates to *modifying* permanent identifiers (e.g., MSID, IMSI, ESN or ISDN numbers) of a mobile communication device to include *actual data*. Typically, if one user wants to send data to another communication device, the

¹ See May 3, 2010 Advisory Action.

communication devices must go through a lengthy process of requesting and establishing a traffic channel. However, the claimed invention provides a way to send actual data to a communication device without going through the lengthy process of *first* establishing a traffic channel. In order to accomplish this, two permanent identifiers such as an IMSI and ESN numbers are *modified* to include the data the user wants to send.

As explained in the background section of the application, the conventional permanent modifiers do not include *actual data*. For instance, the background section provides an example of a typical IMSI number as a first permanent identifier.

IMSI (up to 15 digits) = MCC² (3 digits) + MNC³ (1 to 3 digits) + MSIN (9-11 digits).⁴ The MSIN is “the identification number pre-assigned to the end user 2 by the home system.”⁵

In addition, the background section of the application provides an example of a typical expanded ESN number (EESN) as a second permanent identifier.

EESN (56 bits) = ESN (32 bits) + ESN-expansion (24 bits)
ESN (32 bits) = manufacturer’s code of 128 (8 bits) + identification number (24 bits)
ESN-expansion = expanded manufacture’s code (24 bits.)⁶

As clearly shown above, both of these permanent identifiers do not include *actual data*. Rather, they merely include routing information, manufacture’s codes, and identification numbers. In other words, they operate as conventional *identifiers*.

In contrast, the claimed invention modifies the permanent identifiers to include *actual data*. For example, claim 1 requires: (1) “forming a modified first permanent identifier including a first portion that includes routing information to a home system and a second portion that includes one portion of the received data, the second portion **not** being an identification number of a user” and (2) “forming a modified expanded second permanent identifier having a second permanent identifier portion

² Mobile Country Code

³ Mobile network Code

⁴ Paragraph [0009] of the specification as filed.

⁵ Paragraph [0009] of the specification as filed.

⁶ Paragraph [0013] of the specification as filed.

and an expanded portion, the expanded portion **not** being an identification number of the user.”

The modified first permanent identifier is explained with reference to paragraph [0029], which is reproduced below.

[0029]The first portion of the modified first permanent identifier contains the routing information to the home system 16, but the second portion or a part thereof, which normally includes the user identification number pre-assigned by the home system 16, includes data from the end user 2.

As clearly recited in paragraph [0029], a first portion of the first permanent identifier includes routing information and a second portion includes data received from the end user. Also, as clearly recited in paragraph [0029], the second portion does **not** include a user identification number, but rather data received from the end user.

The modified second permanent identifier is explained with reference to paragraph [0030], which is reproduced below.

[0030]The first portion of the modified expanded second permanent identifier includes the pre-established code to trigger the expanded second permanent identifier, and the second portion includes an identification number as did the conventional expanded second permanent identifier. However, the third or expanded portion of the modified expanded second permanent identifier, which normally includes another identification number, includes data from the end user 2.

The “expanded portion” of the second permanent identifier includes data from the end user – not another identification number (like the one used in the conventional art).

In the Final Office Action, the Examiner relies heavily on the background section of the application as disclosing the above-identified features of claim 1. In relying on the APA, the Examiner states “[a]pplicant does not specify type of data...[t]hus data is generic (broad definition) without type [and] [the] identification number of end user 2, as disclosed by APA in paragraph 0008 is a type of data in addition to routing information.”⁷ We believe this to be clearly wrong. As shown above, the claimed invention directly **EXCLUDES** an identification number of the end user. It is puzzling because the Examiner appears to recognize this fact by stating

⁷ See Office Action, pages 5-6.

"[t]his limitation is data only and not identification of an end user", in the Advisory Action. Applicants submit that the claimed invention clearly distinguishes over the conventional permanent identifiers of the background section. Also, Applicants direct the attention of the Panel to Applicants' March 30, 2010 Request for Reconsideration on pages 10-11 for detailed arguments against the APA.

Furthermore, none of the other cited references teach these features of claim 1. For example, the Examiner relies upon Solomon as teaching "receiving data (payload) in addition to routing information (header providing IP address), virtual link (routing information) to Home Agent, page 54."⁸ Page 54 of Solomon explains what a *standard IP Packet* includes. For example, an IP packet includes a (1) header, and (2) payload (data). However, Solomon does not teach *modifying* a permanent identifier such as an IMSI number, which normally does not include data, to include actual data received from an end user.

In addition, the Examiner relies upon a "modifier called **Decorr**" in Willey as allegedly teaching to modify a permanent identifier to include actual data from an end user. This reference is also misplaced. For example, column 13, lines 3-7 of Willey states "[t]he following function returns an integer, using as arguments the mobile station's IMSI or ESN, the number of resources N and a modifier DECORR. The **modifier serves to decorrelate the values obtained for the various applications from the same mobile station.**" (Emphasis Added). In this case, the modifier (DeCorr) decorrelates values obtained for an application from the same mobile station. However, this is not related to *modifying* a permanent identifier such as an IMSI number, which normally does not include data, to include actual data received from an end user.

In addition, Billstrom fails to overcome these deficiencies as well. Applicants direct the attention of the Panel to page 11 of Applicants' March 30, 2010 Request for Reconsideration for arguments against this reference. For example, column 1, lines 23-28 of Billstrom states "communication of data to or from the communication station is effectuated without necessitating that the communication station be uniquely identified with a permanent identifier unique to the communication station." In other words, Billstrom discloses a system that provides a mobile station with **anonymous access to packet radio services.** In other words, the system in

⁸ See Office Action, page 7.

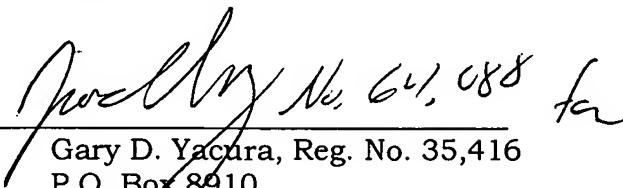
Billstrom allows a mobile station to remain anonymous by not using a permanent identifier associated with the mobile device. The system in Billstrom uses *another method* of authorization (besides using permanent identifiers) in order to authenticate the user for a particular service. Therefore, if Billstrom teaches not using permanent identifiers, then *how* can Billstrom suggest modifying first and second permanent identifiers? As such, Applicants submit that the system in Billstrom that allows the mobile station to remain *anonymous* does not somehow suggest modifying first and second permanent identifiers to additionally include actual data.

As a result, Applicants submit that one of ordinary skill in the art would not realize to modify first and second permanent identifiers such as IMSI or ESN numbers to additionally include actual data from an end user based on the "anonymous access to radio services" of Billstrom, the "standard IP header" of Solomon, and "Decorr modifier" of Willey. Therefore, APA, Solomon, Willey, and Billstrom, alone or in combination cannot render independent claim 1 obvious to one of ordinary skill in the art. Claims 2-12 and 29-30, dependent on claim 1, are patentable for at least the same reasons stated above. Also, independent claim 32 contains features similar to the above-recited features of claim 1, and therefore is patentable for at least the same reasons. As such, Applicants respectfully request that the Panel withdraw this rejection, and have this application allowed.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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